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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,877	04/04/2001	Takafumi Soramoto	P 280041 VN-0071US	1841

909 7590 11/06/2006

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EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/824,877

Applicant(s)

SORAMOTO ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's amendment received on 8/25/2006 is acknowledged and entered. Claims 37-38 are currently amended. Claims 1-3, 10-14, 21-22, and 36 were previously canceled. Claims 4-9, 15-20, and 23-35 were previously withdrawn to Non-elected invention (s) in the applicant's response filed on 3/7/2005. Currently claims 37-38 are pending for examination

***Response to Arguments***

2. The examiner agrees to the applicant's arguments that with the current amendments the indefiniteness have been rendered moot and as such rejections of claims 37-38 under US 112, second paragraph are withdrawn.

The Applicant's arguments filed on 8/25/2006 (see Remarks, page 9) with regards to rejection of claims 37-38 under 35 USC 101 have been considered but are not persuasive because the current amendments do not remove the deficiencies which render the claims 37-38 rejected under 35 USC.101, as presented below.

The applicant argues (see Remarks, page 10) with regards to rejection of claims 37-38 under 35 USC 102 (e) as being anticipated by Walker '722, that Walker '722 does not describe each and every feature of claims 37-38. The examiner respectfully disagrees because the applicant has neither pointed out any error nor provided evidence contrary to the examiner's analysis in rejecting claims 37-38 as being anticipated by Walker '722 on pages 6-7 of the Office action mailed on 5/25/2006.

The applicant argues (see Remarks, page 10), " In so doing, Walker '772 specifically discloses that, in order for system 100 to work and enable the execution of merchandise deals

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with users, each of the POS controllers 116, 118, and 120 have to be connected to credit card processor 124 and banking institution 126, 128, and 130. In this manner, the member stores must register user information with the credit card companies and banks, before merchandise deals can be executed. As such, Walker, '772 fails to teach or suggest that a server for a compensation granting portal site that connects to a plurality of other servers through the Internet through which a user accesses directly to a member store web page from a user terminal, as required by claim 37. ". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a server for a compensation granting portal site that connects to a plurality of other servers through the Internet through which a user accesses directly to a member store web page from a user terminal) are not recited in the body of the rejected claim(s) but instead they are recited as an intended use in a preamble and the limitations recited in the body of the claim do not disclose/recite any connection with the intended use. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is also to be noted that if the intended use limitation as recited in the preamble is added to the body of the claims then also the recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In view of the foregoing analysis, the rejection of claims 37-38 is maintained as being unpatentable as being anticipated by Walker'722.

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3.1. Note 1: Claim 37 is a system (apparatus) claim directed to structural elements of a server, that is a user database, a member store database, a deal database, a merchandise database and a communication interface. Its preamble recites an intended use of the server for letting a user access directly a member store web page from a user terminal. This recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant application the body of the claim comprising the structural elements of a server, that is a user database, a member store database, a deal database, a merchandise database and a communication interface can stand alone without depending upon the intended use, for letting an user access directly a member store web page from a user terminal, recited in the preamble of the claim.

3.2. Note 2: Claim 37 is a system (apparatus) claim directed to structural elements of a server, that is a user database, a member store database, a deal database, a merchandise database and a communication interface. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus in rejecting system claim 37 emphasis has been given that the prior art teaches the structural limitations that is a user database, a member store database, a deal database, a merchandise

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database and a communication interface and not the terms of the intended use/functionality, that is using the server for a compensation-granting portal site on the Internet.

3.3. Note 3: Claim 38 is a method claim and its preamble recites an intended use of the method for granting compensation for a deal performed on the Internet and letting an user access directly a member store web page from a user terminal. This recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant application the body of the claim comprising the steps of storing information of user/member store/deal/merchandise and transmitting the processed results can stand alone without depending upon the intended use, granting compensation for a deal performed on the Internet and letting an user access directly a member store web page from a user terminal, recited in the preamble of the claim.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 37-38 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added), per **State Street test**.

Body of the claim 37 recites a server comprising different types of databases and a communication interface and the server processes information stored in these databases according to programs stored in a CPU, ROM, and a RAM. It is not clear if the claimed invention is a "new and useful machine, or any new and useful improvement thereof". A server could be a computer or program running on a network with several databases and processing the information from these databases. The processed information could be some numbers or data without representing a real world specific practical value and therefore the claim does not qualify the test that it is "useful ", and "concrete" and " tangible". As analyzed above, the limitations recited in the body of the claim do not recite any connection with the intended use recited in the preamble.

Claim 38 recites a process comprising storing different types of data and processing information stored in the various databases. It is not clear if the claimed invention is a "new and useful process, or any new and useful improvement thereof". The processed results could be some numbers or mere data without representing a real world specific practical value and therefore the claim does not qualify the test that it is "useful ", and "concrete" and " tangible". As analyzed above, the limitations recited in the body of the claim do not recite any connection with the intended use recited in the preamble.

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a

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whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601 02. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways: (a) The claimed invention "transforms" an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107.

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application").

For an invention to produce a "concrete" result, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable.

There is no useful, concrete and tangible result produced from claims 37 and 38 and therefore do not satisfy 35 USC 101.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –



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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated  
by Walker et al (US Patent 6,249,772 B1), hereinafter, Walker.

Regarding claim 37, Walker discloses a server for a compensation-granting portal site on the Internet having a first URL, and connecting to a plurality of other servers through the Internet through which a user accesses directly to a member store web page from a user terminal (Note: Walker's central controller system "110" in Fig.1 represents the claimed server and through this server the user accesses directly to the web pages of the retailer web sites, "115".) the server comprising:

- a user database configured to store information of each user corresponding to the user ID (see Fig.2, " 220-customer database", and col.12, lines 22-65);

- a member store database configured to store information of each member store corresponding to the member store ID (see Fig.2-" 218 POS Controller Database" and col.12, lines 22-65. POS controller database stores information about various POS stores );

- a deal database configured to store information of each deal corresponding to the member store ID (see Fig.2-" 222 Transaction Database" and col.12, lines 22-65.);

- an objected merchandise database configured to store information of each merchandise corresponding to the merchandise ID (see Fig.2-" 216 Merchandise Database and col.12, lines 22-65". ); and

- a communication interface configured to grant communication access to a user

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via said URL (see Fig.2 and col.12, lines 22-65. Note: Processor 202 provides communication interface to grant communication access to a user via a communication link 208 and this can be done by using the URL of the web site/portal site comprising the said server );

wherein said server for the compensation-granting portal site processes information stored in said user database, said member store database, said deal database, and said objected merchandise database according to executable instructions stored in a CPU, ROM, and RAM ( see at least col.9, line 57-col.10. line 9 and Figs.1-2 and col.12, lines 22-65) .

Regarding claim 38, all the limitations are closely parallel to the limitations of claim 37 and is therefore analyzed and rejected on the same basis.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Publication 2003/0004809A1 to Palcic discloses a method and system enabling merchant web sites to grant compensations directly to customers and allowing customers to access directly web pages of the merchant websites via a merchant interface (see Fig.1). Palcic's disclosure, see Fig.1, paragraphs 0035-0036 and Abstract).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
10/31/2006